

Serial No. 09/754,465
Attorney Docket No. 10655.9900
AMBX Docket No. 200301935

REMARKS

In reply to the above-identified Office Action, Applicants amend the application and seek reconsideration thereof. In this reply, Applicants amend claims 1, 3, 5, 39 and 40 and cancel claim 2 without prejudice. Applicants do not add any new claims in this reply. Accordingly, claims 1, 3-5, 39 and 40 are pending.

I. Claims Rejected Under 35 U.S.C. § 112

The Examiner rejects claim 5 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully traverse this rejection. In making the rejection, the Examiner states:

Claim 5 is directed to a wallet server receiving a request that includes transaction data from a smart card. However, the Specification merely recites a user using a smart card to authenticate a transaction. The smart card of the Applicant's system does not send transaction data (Specification, page 10, lines 1-5 and 10-31; page 11, lines 10-32).

Applicants amend claim 5 to expedite prosecution by changing its dependency to claim 1 and eliminating its dependence on claim 2, thereby eliminating the statements regarding transaction data from a smart card. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 5.

The Examiner next rejects claim 4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse the rejection. The Examiner asserts "that either the wallet server is, or at least comprises a wallet (Specification, page 10, lines 20-27), which is not clear in light of the Applicant's Disclosure." The specification, for example, at page 3, lines 6-14, discloses:

In general, digital wallets are tools which store personal information (name, address, chargecard number, credit card number, etc.) in order to facilitate electronic commerce or other network interactions. The personal information can be stored on a general server or at a client location (PC or Smartcard) or on a hybrid of both a general server and a client server. Presently, the digital wallet general server is comprised of a Web server and a database server which centrally houses the user's personal and credit card

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information, shopping preferences and profiles of on-line merchants.

Thus, Applicants submit claim 4 particularly points out and distinctly claims the subject matter which Applicants regard as the invention. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 4.

II. Claims Rejected Under 35 U.S.C. - § 103

The Examiner rejects claims 1-5, 39 and 40 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,327,578 issued to Linehan ("Linehan"). Applicants respectfully traverse these rejections.

To render a claim obvious, the relied upon reference must teach or suggest every element of the claim such that the invention, as a whole, would have been obvious at the time of the invention to one skilled in the art. In making the rejection, the Examiner characterizes Linehan as essentially showing, each of the elements of claim 1 in the instance when, by coincidence, a merchant and a user share the same bank or financial institution.

Applicants submit Linehan is limited to computer networks related to electronic commerce. See Linehan, Column 1, lines 5-6. The networks disclosed in Linehan send "from a consumer's computer a start message over an internet to a merchant's computer." Linehan, Column 4, lines 10-12. "The merchant's computer then replies to the consumer's computer with a merchant message including a wallet initiation messages, a merchant digital signature, and a digital certificate from an acquiring bank." Id., lines 12-16. The consumer's wallet program is then started in the consumer's computer in response to the wallet initiation message. "The consumer's computer then sends over the internet network some consumer identity and authentication information, such as a userid and user password, plus the merchant message, to an issuer gateway operating on behalf of an issuing bank." Linehan, Column 4, lines 19-23.

Thus, in Linehan, the users identify and authenticate themselves by entering data, via the keypad, such as a userid and user password. Notably, the Linehan system does not disclose or suggest acquiring data directly off of a transaction instrument. As such, Linehan does not disclose, teach or suggest, for example, "receiving signature data, by a

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wallet server, from a transaction instrument. . . ", as recited by independent claims 1, 39 and 40.

The failure of Linehan to teach or suggest every element of the independent claims 1, 39 and 40 is fatal to the obviousness rejection. Therefore, independent claims 1, 39 and 40 are not obvious over Linehan. Accordingly, Applicants respectfully request withdrawal of the rejection of independent claims 1, 39 and 40.

Claims 3-5 each depend from claim 1 and contain all of the elements thereof. Therefore, Applicants respectfully submit claims 3-5 are not obvious over Linehan and are in condition for allowance at least for the same reasons as claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3-5.

III. Conclusion

In view of the foregoing, Applicants assert that all claims now pending are in condition for allowance. A Notice of Allowance is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (602) 382-6389.

Applicants authorize and respectfully request that any fees due be charged to Deposit Account No. 19-2814.

Respectfully submitted,

Dated: 10/19/04

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